

REMARKS**I. Claim Rejections – 35 U.S.C. § 102****Requirements for Prima Facie Anticipation**

A general definition of *prima facie* unpatentability is provided at 37 C.F.R.

§1.56(b)(2)(ii):

A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the Applicant's claims, the reference cited by the Examiner must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i.e.*, show that the reference cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the Initial state does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to

grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Mehta

Claim 1 was rejected by the Examiner under 35 U.S.C. 102(b) as allegedly anticipated by Mehta, hereinafter "Mehta" (U.S. Patent No. 5,319,522). Regarding claim 1 the Examiner argued, in full, that "Mehta teaches the claimed process as evidenced at figs 5-6." Office Action, Page 2. Applicant respectfully traverses this rejection.

Nevertheless, claim 1 is amended in this Response to recite, in relevant part: "configuring said mold to provide a mold form geometry that permits a plurality of components to be connected electrically to said electrical circuit and an associated latch mechanism after said injection molding of said plastics material into said mold cavity;" and "configuring said mold form geometry to comprise at least one gap in which an additional component can be located." Applicant respectfully submits that neither of the above elements are disclosed, taught, or even suggested in Mehta.

In particular, Mehta teaches, "The polymer fills cavity 28 and substantially completely surrounds encapsulating shell 26, as well as the portions of electrical contact leads 14 which are exposed in cavity 28." Mehta, col. 5, lines 33-36. As such, Applicant respectfully submits that Mehta at least teaches away from "configuring said mold form geometry to comprise at least one gap in which an additional component can be located," as recited in claim 1. For at least this reason, Mehta fails to teach each and every element of claim 1.

Based on the foregoing, Applicant respectfully submits that the rejection of claim 1 under 35 U.S.C. 102(b) has been traversed and overcome. Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. 102(b) be withdrawn.

Norman

Claims 1-5, 7-11, 21-22 and 24-26 were rejected by the Examiner under 35 U.S.C. 102(b) as allegedly anticipated by Norman, hereinafter "Norman" (U.S. Patent No. 5,236,234). Applicant respectfully traverses these rejections.

Specifically, the Examiner argued that "Norman teaches the claimed process as evidenced at col 5, lns 7-44, and figs 1-2 and 8." Office Action, Page 2. Further, the Examiner stated that, "Norman teaches that the electrical circuit is encapsulated and molded into the molding, and the connection tabs of the pressing/circuit are shaped to enable mating with other parts of the latching mechanism." Office Action, Page 2.

Applicant respectfully submits that not only does Norman not teach each and every element as recited in the claims, Norman affirmatively teaches away from the unique combination recited in the claims.

First, Applicant respectfully notes that the claims do not recite an electrical circuit that "is encapsulated and molded into the molding, and the connection tabs of the pressing/circuit are shaped to enable mating with other parts of the latching mechanism." As such, Applicant respectfully asserts that even if Norman does teach such an element, a fact Applicant denies, such teaching would not suffice to show the limitations as actually recited in the claims.

Second, nowhere does Norman teach, "providing a mold having a mold cavity therein," as recited in claims 1, 10, and 21. Instead, Norman teaches an "outer moulding 16", which "has an electrical circuit integrated therewith." Norman, col. 5, lines 7-8. Instead of a "mold cavity", the "circuit pressing is encapsulated and insulated and protected by the plastics material of" Norman's "outer moulding 16." Norman, col. 5, lines 20-22. This missing element is even more evident when considered with the next element that Norman fails to show, as follows.

Third, nowhere does Norman teach, "locating an electrical circuit within said mold cavity, wherein said electrical circuit comprises electrical components

assembled to an electrical circuit board prior to any molding operations thereof," as recited in claims 1, 10, and 21. Instead, Norman's electrical circuit is "a unitary metal etching stamping or pressing" that is "moulded into the moulding 16 and the connecting tabs etc [sic] are shaped as appropriate for mating electrical connections." Norman, col. 5, lines 8-9 and 13-16. Thus, Norman expressly teaches "stamping or pressing" an electrical circuit into a "moulding", and not "locating an electrical circuit within said mold cavity," as recited in the claims. For this reason alone, Norman fails to teach each and every element of the claims, and therefore fails to anticipate the unique combination recited in the claims.

Moreover, claims 1, 10, and 21 recite, "injection molding a plastics material into said mold cavity of said mold, wherein said plastics material covers and seals said electrical circuit to provide insulation and environmental protection to said electrical circuit". Nowhere does Norman even mention "injection molding" and, given the approach Norman takes to providing an electrical circuit into a "moulding", Norman clearly teaches away from injection molding altogether.

More specifically, "injection molding" is clearly inconsistent with "the circuit pressing [being] encapsulated and insulated and protected *by the plastics material of the moulding*," as taught in Norman. Norman, col. 5, lines 20-22 (emphasis added). This important point will be expanded upon in more detail below, in addressing the Examiner's rejections under 35 U.S.C. 103. The fact remains, however, that Norman itself does not teach "injection molding", which also shows that yet another element of the pending claims is missing in Norman.

In fact, the Examiner expressly admits, three times, that Norman does not teach "injection molding": "Norman, however, does not teach injecting the material into the mold cavity." Office Action, Pages 3, 4, and 5-6.

Applicant reminds the Examiner that in order to succeed in a rejection of a claim under 35 U.S.C. 102, the reference utilized as a basis for the rejection must disclose each and every claim limitation of the rejected claim. If even one claim

limitation or feature is missing from the cited reference, the rejection falls and must be withdrawn. In this case, as shown above, Norman completely fails to teach, disclose, or even suggest at least three elements of independent claims 1, 10, and 21. Thus, Applicant respectfully submits that the rejections of claims 1, 10, and 21 fail under the aforementioned *prima facie* anticipation test.

As such, Applicant respectfully suggests that Norman likewise fails to show each and every element of the pending dependent claims, which depend on and further limit claims 1, 10, and 21. Therefore, for the same reasons, Applicant respectfully submits that the rejections of the dependent claims 2, 5, 7-9, 11, and 24-26 also fail under the aforementioned *prima facie* anticipation test.

Based on the foregoing, Applicant respectfully submits that the rejection of claims 1-5, 7-11, 21-22 and 24-26 under 35 U.S.C. 102(b) has been traversed and overcome. Applicant respectfully requests that the rejection of claims 1-5, 7-11, 21-22 and 24-26 under 35 U.S.C. 102(b) be withdrawn.

II. Claim Rejections – 35 U.S.C. § 103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992). Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

Norman in view of Mehta

Claims 1-9, 10-11, and 21-26 were rejected by the Examiner under 35 U.S.C. 103(a) as allegedly unpatentable over Norman in view of Mehta. Applicant respectfully traverses these rejections.

As an initial matter, Applicant notes that the rejections of the three claim sets 1-9, 10-11, and 21-26 are substantially the same. Specifically, as to each claim set, the Examiner argues that Norman teaches the following:

- 1) "providing a mold having a mold cavity formed therein (col 5, lns 7-44, and figs 1-2 and 8)";
- 2) "locating an electrical circuit within the mold cavity"; and
- 3) "molding a plastic material into the mold cavity of the mold, wherein the material covers and seals the circuit to provide insulation and environmental protection to the circuit". Office Action, Pages 3, 4, and 5.

The Examiner admits that Norman fails to teach "Injecting the material into the mold cavity," and offers Mehta to supply that missing element. See *supra*, and Office Action, Pages 3, 4, and 5-6. Specifically, the Examiner argues that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to inject the material of Norman as taught by Mehta in order to facilitate the encapsulation of an electrical circuit." Office Action, Pages 3, 5, and 6. Applicant respectfully disagrees with and traverses this assessment.

First, Applicant respectfully submits that the arguments presented above against the rejections under 35 U.S.C. 102(b) based on Norman and Mehta apply equally to the rejection under 35 U.S.C. 103(a) based on Norman and Mehta.

Second, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. 103(a) based on Norman and Mehta fail under all three prongs of the aforementioned prima facie obviousness test.

Applicant respectfully notes that if only one prong of this test fails to be met, the rejection under 35 U.S.C. 103 fails and must be withdrawn. First, neither Norman nor Mehta provide any suggestion or motivation to combine their teachings to provide for all of the limitations as recited in the independent claims 1, 10, or 21. Second, the Examiner has not provided an explanation of a reasonable expectation of success for such a combination, particularly when the most apparent result of such a combination is an inoperative system, as described in more detail below. Third, the Examiner's proposed combination of Norman and Mehta does not provide for all of the limitations as recited in the independent claims 1, 10, or 21.

As for motivation, Applicant respectfully submits that, as described above, Norman actually teaches away from the Examiner's proposed combination. Specifically, Norman teaches an "outer moulding 16", which "has an electrical circuit integrated therewith." Norman, col. 5, lines 7-8. Norman's electrical circuit is "a unitary metal etching stamping or pressing" that is "moulded into the moulding 16 and the connecting tabs etc [sic] are shaped as appropriate for mating electrical

connections." Norman, col. 5, lines 8-9 and 13-16. As such, the "circuit pressing is encapsulated and insulated and protected by the plastics material of" Norman's "outer moulding 16." Norman, col. 5, lines 20-22. Because the "circuit pressing" is already protected by the "plastics material" of "outer moulding 16", there is simply no reason in Norman to provide an additional "injection molding" as taught by Mehta.

Moreover, Norman's electrical circuit is "a unitary metal etching stamping or pressing" that is "moulded into the moulding 16 and the connecting tabs etc [sic] are shaped as appropriate for mating electrical connections." Norman, col. 5, lines 8-9 and 13-16. Such a configuration leaves no "mold cavity", in which to inject any plastic material, as described above. For at least these two reasons, Norman not only fails to provide the necessary motivation to combine with Mehta, Norman affirmatively teaches away from Mehta. Therefore, for this reason alone the Examiner's rejections fail under the aforementioned prima facie obviousness test.

Second, even if there were some reason to inject some plastic material somewhere into some cavity of Norman, which there clearly is not, the resultant device would not function properly. For example, as stated in Norman, "The latch mechanism is preferable sealed against ingress of damp and dirt" and "the housing or chamber defined by shell 12 and cover 14 [containing the moving mechanical parts] will be sealed at the joint between those components by provision of a suitable elastomeric or other gasket, or by providing integral flexible sealing lips or skirts." Norman, col. 5, lines 45-50. Not only does Norman offer preferred, non-injection, sealing methods, but standard injection molding as taught by Mehta would lock the mechanical parts in place, expressly contrary to Norman's preferred "flexible sealing lips or skirts". Accordingly, for at least these reasons, the Examiner's proposed combination of Norman and Mehta fails to provide a reasonable expectation of success. Therefore, for this reason alone the Examiner's rejections fail under the aforementioned prima facie obviousness test.

Finally, even if there were some reason to include the injection molding of Mehta into the Norman system, the Examiner's proposed combination nonetheless fails to teach each and every element as recited in the claims. In particular, the proposed combination fails to show "configuring said mold to provide a mold form geometry that comprises at least one gap in which an additional component can be located," as recited in claims 1 and 21.

Instead, as described above, Mehta teaches, "The polymer fills cavity 28 and substantially completely surrounds encapsulating shell 26, as well as the portions of electrical contact leads 14 which are exposed in cavity 28." Mehta, col. 5, lines 33-36. As such, Applicant respectfully submits that Mehta at least teaches away from "configuring said mold form geometry to comprise at least one gap in which an additional component can be located," as recited in claim 1. For at least this reason, the Examiner's proposed combination of Norman and Mehta fails to teach each and every element of claim 1. Therefore, for this reason alone the Examiner's rejections fail under the aforementioned prima facie obviousness test, at least as to claims 1 and 21.

Accordingly, Applicant respectfully submits that the Examiner's proposed combination of Norman and Mehta fails under the required prima facie obviousness test as to independent claims 1, 10, and 21. Applicant therefore respectfully requests that the rejections of claims 1, 10, and 21 be withdrawn. Similarly, Applicant respectfully suggests that the Examiner's proposed combination of Norman and Mehta likewise fails to show each and every element of the pending dependent claims, which depend on and further limit claims 1, 10, and 21. Therefore, for the same reasons, Applicant respectfully submits that the rejections of the dependent claims 2-9, 11, and 22-26 also fail under the aforementioned prima facie obviousness test.

Based on the foregoing, Applicant respectfully submits that the rejection of claims 1-9, 10-11, and 21-26 under 35 U.S.C. 103(a) has been traversed and

overcome. Applicant respectfully requests that the rejection of claims 1-5, 7-11, 21-22 and 24-26 under 35 U.S.C. 103(a) be withdrawn.

For similar reasons, Applicant respectfully submits that pending claims 1-2, 5-11, and 21-26 are therefore patentable over Norman, Mehta, and the remaining art of record in any combination.

III. Conclusion

In view of the foregoing discussion, Applicant has responded to each and every rejection of the Office Action. Applicant respectfully requests withdrawal of all rejections under 35 U.S.C. §102 and 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



Dated: January 7, 2007

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